

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Craig L. REDING et al.) Group Art Unit: 2614
)
Application No.: 10/720,952) Examiner: Elahee, MD S.
)
Filed: November 24, 2003) Confirmation No.: 5277
)
For: METHOD AND APPARATUS FOR ADAPTIVE)
MESSAGE AND CALL NOTIFICATION)

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections in the Final Office Action mailed on November 13, 2009. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

Claims 1-14 and 19-26 are pending, under current examination, and the subject of this Pre-Appeal Brief Request for Review. In the Final Office Action, the Examiner:

- 1) rejected claim 26 under 35 U.S.C. § 101;
- 2) rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending U.S. Patent Application No. 10/720,920 (the '920 application);
- 3) rejected claims 1-14 and 19-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,390 to *Abburri* ("*Abburri*") in view of U.S. Patent No. 5,661,788 to Chin ("*Chin*"); and
- 4) rejected claims 1, 12, 15, and 19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2001/0012286 to *Huna* et al. ("*Huna*") in view of *Abburri* and *Chin*.

I. The Final Office Action Does Not Comply With MPEP § 707.07(f)

MPEP § 707.07(f) states, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it" (emphasis added). As discussed below, the finality of the

Office Action is improper because the Final Office Action does not comply with MPEP § 707.07(f), because the Examiner has not addressed Applicants' numerous traversals of the double patenting rejection over the '920 application.

Applicants filed an Amendment on July 6, 2009, pointing out numerous deficiencies of the double patenting rejection over the '920 application. In the Amendment, Applicants noted that the double patenting rejection does not appear to account for amendments presented in both this application and the '920 application (Amendment filed July 6, 2009 at page 10). Furthermore, Applicants noted that any double patenting rejection over the claims of a copending application should be a provisional double patenting rejection (Id.). The Amendment of July 6, 2009 was the third time Applicants have pointed out the deficiencies of the double patenting rejection (See *also* Amendment filed September 4, 2008 at pages 8-9 including footnote 2 and Amendment filed January 23, 2009, pages 8-9).

However, the Final Office Action does not respond to Applicants' numerous traversals of the double patenting rejection. Instead, the double patenting rejection is identical to the double patenting rejection originally asserted on pages 2-3 of the Office Action mailed June 4, 2008. Moreover, Applicants have amended the claims of this application three times, in each case also traversing the double patenting rejection (See Amendments filed September 4, 2008, January 23, 2009, and July 6, 2009). In each case, the Examiner has maintained the double patenting rejection, stating that "claim 1 of the pending application [is] the same as claim 1 of the co-pending application except receiving a notification at a server" (See Office Action mailed June 4, 2008 at pages 2-3, Final Office Action mailed December 22, 2008 at pages 2-3, Office Action mailed April 15, 2009 at pages 2-3, and Final Office Action mailed November 13, 2009 at pages 3-4).

Despite Applicants' repeated traversals of the double patenting rejection, and the numerous amendments presented in this application, the Examiner still has not responded to, or even updated, the double patenting rejection over the '920 application. Moreover, the claims presented in the Amendment filed July 6, 2009 are clearly distinguishable from the most recent amendment in the '920 application, filed November 20, 2008. For example, independent claim 1 currently recites "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call" (emphasis added). The claims of the '920 application do not include such recitations.

Applicants respectfully submit that, in light of Applicants' repeated traversals of the double patenting rejection, numerous amendments filed in both this application and the '920 application, and the clear deficiencies of the merits of the double patenting rejection, the Final Office Action does not comply with MPEP § 707.07(f). The Examiner has not "answer[ed] the substance" of Applicants' numerous traversals of the rejection. For this reason, the finality of the Office Action is clearly improper, and prosecution should be reopened or the claims allowed.

II. The Final Office Action Improperly Introduces New Grounds of Official Notice

The Final Office Action also fails to comply with MPEP 2144.03, which states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

(Emphasis added). Here, the Final Office Action appears to introduce a new grounds of Official Notice in the rejection of claims 1-14 and 19-26 under 35 U.S.C. § 103(a) as being unpatentable over *Abburri* in view of U.S. Patent No. 5,661,788 to *Chin*. However, the Final Office Action does not rely on any documentary evidence to support the Official Notice, despite the finality of the Office Action.

A. Independent Claim 1

In the Amendment filed July 6, 2009, Applicants amended independent claim 1 to recite "converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call" (Amendment at page 2). Applicants also pointed out that neither *Abburri* nor *Chin* teaches or suggests these recitations of independent claim 1 (Amendment at pages 11-12). The Final Office Action includes a "Response to Arguments" section which does not address Applicants' traversal, but merely states that "Applicant[s] remarks ... are moot in view of the new grounds of rejection" (Final Office Action at page 2).

This is incorrect. The Final Office Action does not introduce a new reference to support the rejections under 35 U.S.C. § 103(a). Instead, the Final Office Action relies only on references which were relied on in the non-final Office Action mailed April 15, 2009, and

traversed in the Amendment filed July 6, 2009. Moreover, the Final Office Action concedes that neither *Abburri* nor *Chin* teaches “converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call,” as recited by independent claim 1 (Final Office Action at page 6). Instead, the Final Office Action relies on the entirely unsupported assertion that “converting the incoming call data from the data format for the calling device into a data format for the preferred device is well known in the art” (Id.).

Applicants respectfully submit that the Examiner’s position is tantamount to a new, unsupported taking of Official Notice. Furthermore, as the Official Notice was introduced in a Final Office Action, Applicants have not had the opportunity to traverse the Official Notice. Accordingly, prosecution should be reopened at least because the Final Office Action fails to comply with MPEP 2144.03 with respect to the rejection of independent claim 1.

B. Dependent Claims 23 and 24

The rejection of claims 23 and 24 under 35 U.S.C. § 103(a) has similar deficiencies to those discussed above with respect to independent claim 1. In the Amendment filed July 6, 2009, Applicants added new claims 23 and 24 (Amendment at page 7). The Final Office Action concedes that neither *Abburri* nor *Chin* teaches or suggests the recitations of claims 23 and 24 (Final Office Action at page 10). Instead, the Final Office Action simply asserts that the recitations of dependent claims 23 and 24 “would have been obvious,” again without providing any documentary evidence to support the rejection.

Here again, the Examiner’s position is tantamount to a new taking of Official Notice. As discussed above, the Final Office Action merely alleges that the recitations of newly-presented dependent claims 23 and 24 are obvious, without any evidence to support the allegation. Accordingly, prosecution should be reopened at least because the Final Office Action fails to comply with MPEP 2144.03 with respect to the rejection of new dependent claims 23 and 24.

III. The Rejection of Claim 26 Under 35 U.S.C § 101

The Final Office Action alleges that claim 26 recites non-statutory subject matter (Final Office Action at pages 2-3). However, claim 26 recites “[a] computer-readable medium comprising instructions operable to cause a processor to ... store[,] ... receive[,] ... convert[,] ... [and] transmit.” The Final Office Action apparently interprets Applicants

claimed "computer-readable medium" to include a "carrier signal" (Final Office Action at page 3).

Applicants respectfully submit that the Examiner's interpretation of the claimed "computer-readable medium" to encompass nonstatutory signals is incorrect. MPEP 2111 states that "[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach" (emphasis added). Those skilled in the art do not interpret the term "computer-readable medium" to encompass a non-statutory signal. Moreover, nothing in Applicants' disclosure indicates that the term should be read to encompass such nonstatutory signals. Accordingly, claim 26 recites statutory subject matter.

IV. Conclusion

To the extent that the rejections of record are not addressed above, Applicants note that the rejections are adequately addressed by the Amendment filed July 6, 2009. In particular, with respect to the rejections of the pending claims under 35 U.S.C. § 103(a), the claims are distinguishable from the cited references for at least the reasons set forth in the Amendment on pages 11-14.

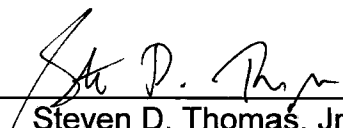
For the reasons set forth above, Applicants respectfully submit that the Final Office Action clearly fails to comply with both MPEP 707.07(f) and 2144.03. Accordingly, Applicants have not had the opportunity to have their reasoning addressed while prosecution is opened, nor the opportunity to traverse several new grounds of Official Notice. Thus, the finality of the Office Action is improper, and Applicants request that the Examiner reopen prosecution, withdraw the rejection, and allow the claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 17, 2009

By: 
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